

Application No.: 10/644,555

Docket No.: 19036/39398

REMARKS

Claims 1-9 and 18-22 are pending and at issue. Claims 10-17 and 23-27 were withdrawn, without prejudice to their reinstatement, as directed to non-elected species. All of the pending claims stand rejected on prior art grounds under 35 U.S.C. §103. By amendment above, the applicants have amended independent claim 1 to recite the subject matter of dependent claim 6, and independent claim 18 to recite the subject matter of dependent claims 21 and 22. As noted below, none of the prior art whether taken alone or in combination teaches or suggests this recited subject matter.

Independent Claim 1

Claim 1 has been amended to recite a multi-layered film having a third film having a refractive index assuming a value falling within a range from 2.2 to 2.4. Based on the rejection of claim 6, which originally cited such subject matter, the Examiner seems to confuse the refractive index of the film with the refractive index of a material in the film. The two are completely and notably different. It is the refractive index of the film that is recited in claim 1.

By way of background, microscopically, a film formed on a substrate has minute gaps between particles. The refractive index of the film, as a result, is an average of the refractive index of the material forming the film and a refractive index of the minute gaps (i.e., refractive index of air : 1) between the particles of the material. Thus, it follows that the actual refractive index of the film is inevitably smaller than the refractive index of the material used to form the film. As described in page 7 line 25 to page 6 line 2 in specification, in the prior art example, the actual refractive index of the film is 2.15 or less. On the other hand, in examples within the pending application, e.g., as described at page 26 lines 10-18, a third film may be formed by a method employing a special ion plating, that produces a dense third film with less minute gaps. As a result, the refractive index of the film increases due to fewer gaps between material particles.

Regarding *Sato*, which the Examiner principally relies upon in rejecting claim 6, the Examiner points to material of the film and its refractive index, not the refractive index of the film. *Sato*'s actual film has a refractive index (2.05), i.e., outside the claimed range. See *Sato* at 6:1 et seq.

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Neither *Sato*, *Ichikawa*, *Nakahigashi*, nor any of the art of record discloses or suggests a third film with a refractive index of 2.2 to 2.4, as recited in claim 1. The rejections of claim 1 and claims 2-9 depending therefrom are traversed and reconsideration is requested.

Amended Claim 18

Amended claim 18 recites that the film is formed by applying a bias voltage having a negative mean value and a positive maximum value. By doing so, the resulting third film may be made dense and hence with a refractive index as high as 2.2 to 2.4, in some examples.

As pointed out by the Examiner, none of the prior art discloses the process for forming the film by applying the bias voltage having the negative mean value and the positive maximum value. The Examiner, instead, states that this process is either inherent or would have been an obvious matter of design choice to one skilled in the art. The Applicants respectfully traverse.

As to inherency, as the Examiner is undoubtedly aware, for a teaching to be inherent, the teaching must necessarily be present in the single prior art disclosure. *See, e.g., Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048 (Fed. Cir. 1994). Courts do not allow inherency challenges based on mere possibility or conjecture. "The mere fact that a certain thing may result from a given set of circumstances is insufficient to prove anticipation." *Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). The Examiner has pointed to nothing in the prior art that supports inherency, beyond simple conjecture. The inherency rejection is improper and should be removed.

As to obvious design choice, the Examiner has pointed to nothing in the prior art that would suggest using the claimed technique with the CVD deposition of *Nakahigashi* or any other art of record. Yet, to establish *prima facie* obviousness, there must be some teaching, suggestion, or motivation from the prior art to make the proposed combination or modification. One cannot rely upon the mere fact that references can be combined or modified, unless the prior art also suggests the desired combination. MPEP §2143.01 *citing In re Mills*, 916 F.2d 860 (Fed. Cir. 1992). Nor may one maintain a rejection based on the notion that the claimed subject matter was within the capabilities of one of ordinary skill in the art. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993) (stating that

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a rejection that the claimed inventions would have been well within the ordinary skill of the art at the time the invention was made is not sufficient to establish a *prima facie* case of obviousness). The office action does not show where the prior art suggests a motivation to use the recited technique or where the prior art recognizes any expectation of success in making the purported change. In re Royka, 490 F.2d 981, 984 (CCPA 1974). As instructed many times, both the suggestion to try and the expectation of success must be found in the prior art, not in the applicant's disclosure. Amgen Inc. v. Chugai Pharmaceutical Co. Ltd., 927 F.2d 1200, 1207 (Fed. Cir. 1991), citing In re Dow Chemical Co., 837 F.2d 469, 475 (Fed. Cir. 1988).

The omission of a *prima facie* showing is particularly glaring in the instant case, where the claimed process can produce heretofore unexpected results, results unattainable with the prior art. Without knowing of these unexpected results, such a process would not have been selected and used in the prior art. In fact, the applicants respectfully submit that these results are further evidence of non-obviousness.

In any event, the rejections of claim 18 and claims 19-22 depending therefrom are traversed and reconsideration is requested.

In view of the above amendment, applicant believes the pending application is in condition for allowance. To expedite allowance, the applicants file a request for telephonic interview, Form PTOL-413A, herewith.

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Respectfully submitted,

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